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PATENT
Attorney Docket No.: A-66566-3/RFT/RMS/RMK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BLACKBURN, et al.

Serial No.: 09/440,371

Filed: November 12, 1999

For: BINDING ACCELERATION
TECHNIQUES FOR THE
DETECTION OF ANALYTES

) Examiner: Not Assigned
)
)

) Group Art Unit: 1643
)
)

#3

RECEIVED

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OFFICE OF PETITIONS
DEPUTY A/C PATENTS

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed enclosures, is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on MAR 6 - 2000.

Signed: Todd V. Leone

Todd V. Leone

PETITION UNDER 37 C.F.R. § 1.47(a)

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

The following is a petition under 37 C.F.R. § 1.47(a) to accept the enclosed declaration, which is missing the signature of one of the co-inventors. Applicants enclose a fee of \$130.00 as required under 37 C.F.R. § 1.17(i) in support of this petition.

The Commissioner is authorized to charge any additional fees which may be required or credit any overpayment to Deposit Account No. 06-1300 (Our Order No. A66566-3/RFT/RMS).

Robin Silva is the attorney who prepared the above-identified application. In this application and in this petition under 37 C.F.R. § 1.47, she represents the interests of Clinical Micro Sensors, Inc. (Hereinafter "CMS").

Upon information and belief, the subject matter of the application was conceived and developed by Gary F. Blackburn, Stephen E. Creager, Scott Fraser, Bruce D. Irvine, Thomas J. Meade, Robert H. Terbrueggen, Jost G. Vielmetter, Thomas W. Welch and Stephen D. O'Connor (the 'inventors') while employed by CMS. Gary F. Blackburn, Stephen E. Creager, Scott Fraser, Bruce D. Irvine, Thomas J. Meade, Robert H. Terbrueggen, Jost G. Vielmetter and Thomas W. Welch have signed the declaration for the application and assignment of the application to CMS.

The application was prepared based on one provisional application U.S.S.N. 60/090,389, filed May 23, 1998, in the names of Jon Faiz Kayyem and Gary Blackburn; two utility applications U.S.S.N. 09/134,058, filed August 14, 1998, in the names of Jon Faiz Kayyem, Gary Blackburn and Stephen D. O'Connor; and U.S.S.N. 09/338,726, filed May 23, 1999, in the names of Gary F. Blackburn, Stephen E. Creager, Scott Fraser, Bruce D. Irvine, Thomas J. Meade, Robert H. Terbrueggen, Jost G. Vielmetter and Thomas W. Welch. Both of the utility applications were prepared with the assistance (including scientific input and/or data) of Stephen D. O'Connor and he signed the Declaration and Assignment for both applications.

On February 13 1999 Stephen D. O'Connor terminated his status as an employee of CMS.

After receiving the Notice to File Missing Parts, a letter was sent to CMS on January 12, 2000 requesting that the declaration and assignment be signed and dated by

each inventor. A copy of the letter requesting that the declaration and assignment be signed and dated is attached as Exhibit 1.

On February 22, 2000 Stephen D. O'Connor was notified, via facsimile, that if he did not want to review or receive confidential CMS information, including the pending application, that this would be interpreted as an express refusal to sign the "Declaration for Patent Application". A copy of the facsimile is attached as Exhibit 2.

On February 22, 2000 Stephen D. O'Connor, via facsimile, confirmed in writing his refusal to sign the "Declaration for Patent Application". A copy of this facsimile is attached as Exhibit 3.

Accordingly, as required by 37 C.F.R. §1.47 and M.P.E.P. §409.03(d), the applicants have met the requirements for proving a refusal to sign the declaration and assignment.

Stephen D. O'Connor is obligated by agreement with CMS to assign his entire interest in the subject matter of the application to CMS. A copy of the Agreement executed by Stephen D. O'Connor when he joined CMS is attached as Exhibit 4. Section 2(b) of the Agreement requires the assignment of all inventions made by the employee in the course of her employment. Section 2(e) of the Agreement requires that the employee assist the Company in obtaining patent rights covering all inventions and original works of authorship assigned to the Company and that this obligation shall continue beyond termination of employment.

In accordance with her employment agreement, Section 2(e), Dr. Gary Blackburn has signed the assignment on Stephen D. O'Connor's behalf.

Stephen D. O'Connor currently resides at 4222 South El Molino, Apt. 16,
Pasadena, California 91101.

Dated: 3/3, 2000

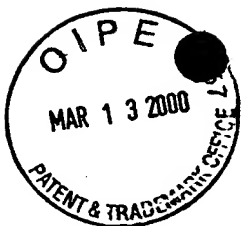
Respectfully submitted,

FLEHR HOHBACH TEST
ALBRITTON & HERBERT, LLP

By: Robin M. Silva
Robin M. Silva
Reg. No. 38,304

Four Embarcadero Center, Suite 3400
San Francisco, California 94111-4187
Telephone: (415) 781-1989
Facsimile: (415) 398-3249

SF-1010485v1



PATENT

Attorney Docket No.: A-66566-3/RFT/RMS/RMK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:) Examiner: Not Assigned
)
BLACKBURN, et al.) Group Art Unit: 1643
)
Serial No.: 09/440,371)
)
Filed: November 12, 1999)
)
For: BINDING ACCELERATION)
TECHNIQUES FOR THE)
DETECTION OF ANALYTES)
)

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed enclosures, is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on **MAR 6 - 2000**.

Signed:

Todd V. Leone

DECLARATION OF ROBIN M. SILVA UNDER 37 C.F.R. § 1.47(a)

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

I, ROBIN M. SILVA, declare that:

1. I am the attorney who prepared the above-identified application. In this application and in this petition under 37 C.F.R. § 1.47, I am representing the interests of Clinical Micro Sensors, Inc. (Hereinafter "CMS").
2. Upon information and belief, the subject matter of the application was conceived and developed by Gary F. Blackburn, Stephen E. Creager, Scott Fraser, Bruce D. Irvine, Thomas J. Meade, Robert H. Terbrueggen, Jost G. Vielmetter,

Thomas W. Welch and Stephen D. O'Connor (the 'inventors') while employed by CMS. Gary F. Blackburn, Stephen E. Creager, Scott Fraser, Bruce D. Irvine, Thomas J. Meade, Robert H. Terbrueggen, Jost G. Vielmetter and Thomas W. Welch have signed the declaration for the application and assignment of the application to CMS.

3. The application was prepared based on one provisional application U.S.S.N. 60/090,389, filed May 23, 1998, in the names of Jon Faiz Kayyem and Gary Blackburn; two utility applications U.S.S.N. 09/134,058, filed August 14, 1998, in the names of Jon Faiz Kayyem, Gary Blackburn and Stephen D. O'Connor; and U.S.S.N. 09/338,726, filed May 23, 1999, in the names of Gary F. Blackburn, Stephen E. Creager, Scott Fraser, Bruce D. Irvine, Thomas J. Meade, Robert H. Terbrueggen, Jost G. Vielmetter and Thomas W. Welch. Both of the utility applications were prepared with the assistance (including scientific input and/or data) of Stephen D. O'Connor and he signed the Declaration and Assignment for both applications. However, due to time constraints, the present application was filed without the inventors' signatures.
4. On February 13 1999 Stephen D. O'Connor terminated his status as an employee of CMS.
5. After receiving the Notice to File Missing Parts, a letter was sent to CMS on January 12, 2000 requesting that the declaration and assignment be signed and dated by each inventor. A copy of the letter requesting that the declaration and assignment be signed and dated is attached as Exhibit 1.
6. On February 22, 2000 Stephen D. O'Connor was notified, via facsimile, that if he did not want to review or receive confidential CMS information,

including the pending application, that this would be interpreted as an express refusal to sign the "Declaration for Patent Application". A copy of the facsimile is attached as Exhibit 2.

7. On February 22, 2000 Stephen D. O'Connor, via facsimile, confirmed in writing his refusal to sign the "Declaration for Patent Application". A copy of this facsimile is attached as Exhibit 3.

8. Accordingly, as required by 37 C.F.R. §1.47 and M.P.E.P. §409.03(d), the applicants have met the requirements for proving a refusal to sign the declaration and assignment.

9. Stephen D. O'Connor is obligated by agreement with CMS to assign his entire interest in the subject matter of the application to CMS. A copy of the Agreement executed by Stephen D. O'Connor when he joined CMS is attached as Exhibit 4. Section 2(b) of the Agreement requires the assignment of all inventions made by the employee in the course of her employment. Section 2(e) of the Agreement requires that the employee assist the Company in obtaining patent rights covering all inventions and original works of authorship assigned to the Company and that this obligation shall continue beyond termination of employment.

10. In accordance with her employment agreement, Section 2(e), Dr. Gary Blackburn Vice President of Scientific Affairs, an officer of CMS who is authorized to act on CMS's behalf, has signed the assignment on Stephen D. O'Connor's behalf.

11. Stephen D. O'Connor currently resides at 4222 S. El Molino, Apt. 16, Pasadena, CA 91101.

12. All statements made herein of my own knowledge are true and all statements on information and belief are believed to be true. All statements made by me herein are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of title 18 of the United States Code, and that any willful false statements may jeopardize the validity of any patent resulting therefrom.

Dated: 3/3, 2000

Signed: Robin M. Silva
Robin M. Silva
Reg. No. 38,304

**FLEHR
HOHBACH
TEST
ALBRITTON
& HERBERT
LLP**

Intellectual Property Law

January 12, 2000

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Larry Mendenhall
Diane J. Mason
William E. Nuttle
Jeffrey S. Wax
*John W. Crosby

*Member of Colorado Bar

OF COUNSEL
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Jerry G. Wright

Paul D. Flehr
(1898-1992)
Elmer S. Albritton
(1922-1988)

Dr. Gary Blackburn
Clinical Micro Sensors, Inc.
101 Waverly Drive
Pasadena, California 91105

Re: BLACKBURN, et al.
U.S. Patent Serial No. 09/440,371
Filed: November 12, 1999
***Binding Acceleration Techniques for the Detection
of Analytes***
Our Ref: A-66566-3/RFT/RMS/RMK

Dear Gary:

We have now received the Missing Parts Notice for the referenced application. The response is due **February 8, 2000**, and this date can be extended by four months. The final date by which a response must be filed is **June 8, 2000**. We are forwarding for execution by yourself and the inventors the documents listed below. Please note the instructions given for the execution of each document:

- 1) Declaration for Patent Application - attached to a copy of the as-filed patent application to be signed and dated by the inventors, (Yourself, Stephen E. Creager, Scott Fraser, Bruce D. Irvine, Thomas J. Meade, Stephen D. O'Connor, Robert H. Terbruggen, Jost G. Vielmetter, and Thomas W. Welch). Each of the inventors should review the entire application, **including the claims**, for accuracy and completeness before signing the Declaration. The inventors need to complete **each line** indicated by a red "X".
- 2) Assignment - to be signed and dated by each inventor. Please note, the Assignment signatures **must be notarized**.

If you find that obtaining the notary signature delays the return of the other documents, please be advised that the Assignment can be filed at any time and does not carry a due date.

- 3) Power of Attorney by Assignee - to be signed by an officer of Clinical Micro Sensors, Inc.. Please note that the Power of Attorney must be signed **after the Assignment is signed**.

Dr. Gary Blackburn
Clinical Micro Sensors, Inc.
January 12, 2000
Page 2

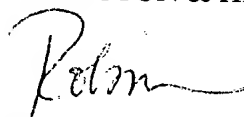
- 4) Verified Statement (Declaration) Claiming Small Entity Status - Small Business Concern - to be signed and dated by an officer of Clinical Micro Sensors, Inc.. Please note that this statement may only be signed if all parties having rights in the application each have fewer than 500 employees or have non-profit status.

Please be advised that all inventors owe a continuing Duty of Candor to the United States Patent and Trademark Office throughout the pendency of the patent application process. That means all inventors must disclose to the United States Patent and Trademark Office any material prior art of which the inventors are aware. If any of the inventors become aware of any such prior art or have questions about the duty to disclose, please contact me.

If you have any questions regarding the formal papers, please give me a call.

Yours very truly,

FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP



Robin M. Silva

RMS/gc

Enclosures

cc: Richard F. Trecartin, Esq. (w/out encl)

1006522

FLEHR
HOHBACH
TEST
ALBRITTON
& HERBERT
LLP

Intellectual Property Law

FACSIMILE TRANSMITTAL SHEET

Telephone: (415) 781-1989
Fax: (415) 398-3249

4 Embarcadero Center - Suite 3400
San Francisco, California 94111-4187

DATE: 22 February 2000

FROM: Renee M. Kosslak

TO: Dr. Stephen D. O'Connor
2275 East Foothill Boulevard
Pasadena, California 91107

FAX NO.: (626) 535-9620

TEL. NO.: (626) 893-2514

NUMBER OF PAGES (including this transmittal sheet): 3

If you do not receive clear copies of any pages, please let us know.

RE: U.S. Patent Application
Serial No.: 09/440,371
Filing Date: 12 November 1999
For: **Binding Acceleration Techniques
for the Detection of Analytes**
Inventors: Blackburn et al.
Our File No.: A-66566-3/RFT/RMS/RMK

MESSAGE:

Please see attached page(s).

IMPORTANT/CONFIDENTIAL: This facsimile communication is intended only for the use of the individual or entity to which it is addressed. The following pages contain information which may be privileged and/or confidential. If the reader of this facsimile is not the intended recipient, or the employee or agent responsible for delivering the facsimile to the intended recipient, you are hereby notified that any disclosure of the contents, or dissemination or distribution of this facsimile to others, or copying of this communication, is strictly prohibited. If you have received this communication in error, please telephone us immediately at (415) 781-1989 and return all copies of this facsimile to us by mail. We thank you for your cooperation.

SF-1010434v1

APPLICANT'S EXHIBIT	2
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PATENT

Attorney Docket No.: A-66566-3/RFT/RMS/RMK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Examiner: Not Assigned
)	
BLACKBURN, et al.)	Group Art Unit: 1643
)	
Serial No.: 09/440,371)	
)	
Filed: November 12, 1999)	
)	
For: BINDING ACCELERATION)	
TECHNIQUES FOR THE)	
DETECTION OF ANALYTES)	
)	

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Signed: Todd V. Leone

Todd V. Leone

DECLARATION UNDER 37 C.F.R. § 1.47(a) BY GARY F. BLACKBURN FOR APPLICATION ON BEHALF OF STEPHEN D. O'CONNOR

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

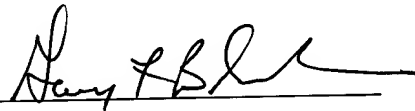
I, GARY F. BLACKBURN, declare that:

1. I am an original and joint inventor of the subject matter which is claimed in the captioned application. I reside at 261 N. Lone Hill Avenue, Glendora, CA 91741.
2. I believe that Stephen D. O'Connor is also a joint inventor of certain subject matter which is claimed in the captioned application.

3. I have reviewed and understand the contents of the specification and claims as originally filed in the application and executed declarations for the application on behalf of myself and Stephen D. O'Connor.

4. All statements made herein of my own knowledge are true and all statements on information and belief are believed to be true. Furthermore, all statements made by me herein are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of title 18 of the United States Code, and that any willful false statements may jeopardize the validity of any patent resulting therefrom.

Date: 2/24/00

Signed: 

Gary Blackburn

1010463v1



PATENT

Attorney Docket No.: A-66566-3/RFT/RMS/RMK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Examiner: Not Assigned
)	
BLACKBURN, et al.)	Group Art Unit: 1643
)	
Serial No.: 09/440,371)	
)	
Filed: November 12, 1999)	
)	
For: BINDING ACCELERATION)	
TECHNIQUES FOR THE)	
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Signed: _____

Todd V. Leone

DECLARATION UNDER 37 C.F.R. § 1.47(a) BY THOMAS J. MEADE FOR APPLICATION ON BEHALF OF STEPHEN D. O'CONNOR

Assistant Commissioner of Patents
Washington, DC 20231

Sir:


I, THOMAS J. MEADE, declare that:

1. I am an original and joint inventor of the subject matter which is claimed in the captioned application. I reside at 1656 New York Drive, Altadena, CA 91001.
2. I believe that Stephen D. O'Connor is also a joint inventor of certain subject matter which is claimed in the captioned application.

3. I have reviewed and understand the contents of the specification and claims as originally filed in the application and executed declarations for the application on behalf of myself and Stephen D. O'Connor.

4. All statements made herein of my own knowledge are true and all statements on information and belief are believed to be true. Furthermore, all statements made by me herein are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of title 18 of the United States Code, and that any willful false statements may jeopardize the validity of any patent resulting therefrom.

Date: 2-24-00

Signed: 
Thomas J. Meade

1010473v1



PATENT

Attorney Docket No.: A-66566-3/RFT/RMS/RMK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Examiner: Not Assigned
)	
BLACKBURN, et al.)	Group Art Unit: 1643
)	
Serial No.: 09/440,371)	
)	
Filed: November 12, 1999)	
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For: BINDING ACCELERATION)	
TECHNIQUES FOR THE)	
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_____)	

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Signed: Todd V. Leone
Todd V. Leone

DECLARATION UNDER 37 C.F.R. § 1.47(a) BY STEPHEN E. CREAGER FOR APPLICATION ON BEHALF OF STEPHEN D. O'CONNOR

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

I, STEPHEN E. CREAGER, declare that:

1. I am an original and joint inventor of the subject matter which is claimed in the captioned application. I reside at 357 Cross Creek Road, Central, South Carolina 29630.
2. I believe that Stephen D. O'Connor is also a joint inventor of certain subject matter which is claimed in the captioned application.

3. I have reviewed and understand the contents of the specification and claims as originally filed in the application and executed declarations for the application on behalf of myself and Stephen D. O'Connor.

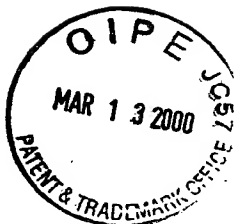
4. All statements made herein of my own knowledge are true and all statements on information and belief are believed to be true. Furthermore, all statements made by me herein are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of title 18 of the United States Code, and that any willful false statements may jeopardize the validity of any patent resulting therefrom.

Date: Feb 25, 2000

Signed: Stephen E Creager

Stephen E. Creager

1010469v1



PATENT

Attorney Docket No.: A-66566-3/RFT/RMS/RMK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BLACKBURN, et al.

Serial No.: 09/440,371

Filed: November 12, 1999

For: BINDING ACCELERATION
TECHNIQUES FOR THE
DETECTION OF ANALYTES

Examiner: Not Assigned

Group Art Unit: 1643

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Signed: Todd V. Leone

Todd V. Leone

**DECLARATION UNDER 37 C.F.R. § 1.47(a) BY SCOTT FRASER FOR
APPLICATION ON BEHALF OF STEPHEN D. O'CONNOR**

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

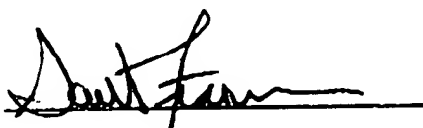
I, SCOTT FRASER, declare that:

1. I am an original and joint inventor of the subject matter which is claimed in the captioned application. I reside at 503 Dartmouth Place, La Canada, CA 91011.
2. I believe that Stephen D. O'Connor is also a joint inventor of certain subject matter which is claimed in the captioned application.

3. I have reviewed and understand the contents of the specification and claims as originally filed in the application and executed declarations for the application on behalf of myself and Stephen D. O'Connor.

4. All statements made herein of my own knowledge are true and all statements on information and belief are believed to be true. Furthermore, all statements made by me herein are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of title 18 of the United States Code, and that any willful false statements may jeopardize the validity of any patent resulting therefrom.

Date: 3 MAR 00

Signed: 
Scott Fraser

1010470v1



PATENT

Attorney Docket No.: A-66566-3/RFT/RMS/RMK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Examiner: Not Assigned
)	
BLACKBURN, et al.)	Group Art Unit: 1643
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Serial No.: 09/440,371)	
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Signed: _____

Todd V. Leone

DECLARATION UNDER 37 C.F.R. § 1.47(a) BY BRUCE D. IRVINE FOR APPLICATION ON BEHALF OF STEPHEN D. O'CONNOR

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

I, BRUCE D. IRVINE, declare that:

1. I am an original and joint inventor of the subject matter which is claimed in the captioned application. I reside at 430 Vista Bonita Avenue, Glendora, CA 91741.
2. I believe that Stephen D. O'Connor is also a joint inventor of certain subject matter which is claimed in the captioned application.

3. I have reviewed and understand the contents of the specification and claims as originally filed in the application and executed declarations for the application on behalf of myself and Stephen D. O'Connor.

4. All statements made herein of my own knowledge are true and all statements on information and belief are believed to be true. Furthermore, all statements made by me herein are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of title 18 of the United States Code, and that any willful false statements may jeopardize the validity of any patent resulting therefrom.

Date: 2/24/00

Signed: 

Bruce D. Irvine

1010472v1



PATENT

Attorney Docket No.: A-66566-3/RFT/RMS/RMK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Examiner: Not Assigned
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BLACKBURN, et al.)	Group Art Unit: 1643
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Serial No.: 09/440,371)	
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Todd V. Leone

DECLARATION UNDER 37 C.F.R. § 1.47(a) BY ROBERT H. TERBRUEGGEN FOR APPLICATION ON BEHALF OF STEPHEN D. O'CONNOR

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

I, ROBERT H. TERBRUEGGEN, declare that:

1. I am an original and joint inventor of the subject matter which is claimed in the captioned application. I reside at 4413B The Strand, Manhattan Beach, CA 90266.
2. I believe that Stephen D. O'Connor is also a joint inventor of certain subject matter which is claimed in the captioned application.

3. I have reviewed and understand the contents of the specification and claims as originally filed in the application and executed declarations for the application on behalf of myself and Stephen D. O'Connor.

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Date: 2-24-2000

Signed: Robert H. Terbrueggen

Robert H. Terbrueggen

1010474v1



PATENT

Attorney Docket No.: A-66566-3/RFT/RMS/RMK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Examiner: Not Assigned
)	
BLACKBURN, et al.)	Group Art Unit: 1643
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Signed: _____

Todd V. Leone

DECLARATION UNDER 37 C.F.R. § 1.47(a) BY JOST G. VIELMETTER FOR APPLICATION ON BEHALF OF STEPHEN D. O'CONNOR

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

I, JOST G. VIELMETTER, declare that:

1. I am an original and joint inventor of the subject matter which is claimed in the captioned application. I reside at 69 South Greenwood Avenue, Pasadena, CA 91107.
2. I believe that Stephen D. O'Connor is also a joint inventor of certain subject matter which is claimed in the captioned application.

3. I have reviewed and understand the contents of the specification and claims as originally filed in the application and executed declarations for the application on behalf of myself and Stephen D. O'Connor.

4. All statements made herein of my own knowledge are true and all statements on information and belief are believed to be true. Furthermore, all statements made by me herein are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of title 18 of the United States Code, and that any willful false statements may jeopardize the validity of any patent resulting therefrom.

Date: Feb. 24, 00

Signed: _____

Jost G. Vielmetter

1010477v1



PATENT

Attorney Docket No.: A-66566-3/RFT/RMS/RMK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Examiner: Not Assigned
)	
BLACKBURN, et al.)	Group Art Unit: 1643
)	
Serial No.: 09/440,371)	
)	
Filed: November 12, 1999)	
)	
For: BINDING ACCELERATION)	
TECHNIQUES FOR THE)	
DETECTION OF ANALYTES)	

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed enclosures, is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on MAR 8 - 2000

Signed: Todd V. Leone

Todd V. Leone

DECLARATION UNDER 37 C.F.R. § 1.47(a) BY THOMAS W. WELCH FOR APPLICATION ON BEHALF OF STEPHEN D. O'CONNOR

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

I, THOMAS W. WELCH, declare that:

1. I am an original and joint inventor of the subject matter which is claimed in the captioned application. I reside at 677 S. Marengo Avenue, Apt. 6, Pasadena, CA 91106.

2. I believe that Stephen D. O'Connor is also a joint inventor of certain subject matter which is claimed in the captioned application.

3. I have reviewed and understand the contents of the specification and claims as originally filed in the application and executed declarations for the application on behalf of myself and Stephen D. O'Connor.

4. All statements made herein of my own knowledge are true and all statements on information and belief are believed to be true. Furthermore, all statements made by me herein are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of title 18 of the United States Code, and that any willful false statements may jeopardize the validity of any patent resulting therefrom.

Date: 2/24/2000

Signed: 

Thomas W. Welch

1010478v1

**FLEHR
HOHBACH
TEST
ALBRITTON
& HERBERT
LLP**

Intellectual Property Law

22 February 2000

VIA FACSIMILE

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James A. Sheridan
Robert B. Chickering
Richard F. Trecartin
Steven F. Caserza
Laura L. Kulhanjian
Edward N. Bachand
R. Michael Ananian
Robin M. Silva
David C. Ashby
Michael A. Kaufman
Stephen M. Knauer
Karen S. Smith
Janet E. Muller
David P. Campbell
Maria S. Swiatek
Dolly A. Vance
Todd A. Lorenz
Brian G. Hart
Joseph Lutz
Steven M. Freeland
Larry Mendenhall
Diane J. Mason
William E. Nuttle
Jeffrey S. Wax
Victor E. Johnson
John W. Crosby

OF COUNSEL
Julian Caplan
Jerry G. Wright

Paul D. Flehr
(1898-1992)
Elmer S. Albritton
(1922-1988)

Dr. Stephen D. O'Connor
2275 East Foothill Boulevard
Pasadena, California 91107

Re: U.S. Patent Application
Serial No.: 09/440,371
Filing Date: 12 November 1999
For: ***Binding Acceleration Techniques for
the Detection of Analytes***
Inventors: Blackburn *et al.*
Our File No.: A-66566-3/RFT/RMS/RMK

RECEIVED

MAR 15 2000

OFFICE OF PETITIONS
DEPUTY A/C PATENTS

Dear Dr. O'Connor:

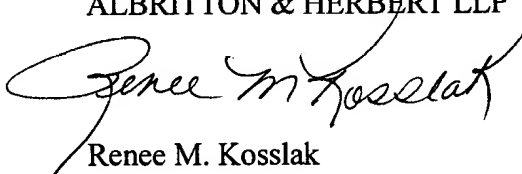
We understand that you do not want to review or receive confidential Clinical Micro Sensors, Inc. information. As a result, you do not want to review this patent application. Accordingly, we understand this to be an express refusal to sign the "Declaration for Patent Application."

Please confirm by signing and returning a copy of page 2 of this letter.

As always, I am working with Robin M. Silva on this case. Please contact us if you have questions or comments.

Very truly yours,

FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP


Renee M. Kossiak

RMK/tvl
SF-1010415v1

cc: Gary F. Blackburn, Ph.D.
Robin M. Silva, Esq.
Richard F. Trecartin, Esq.

VIA FACSIMILE

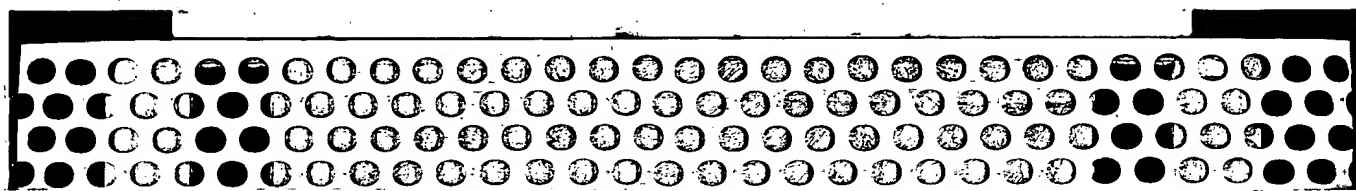
TO: Renee M. Kosslak
Flehr Hohbach Test Albritton & Herbert LLP
Four Embarcadero Center - Suite 3400
San Francisco, California 94111-4187
Fax: (415) 398-3249
Tel.: (415) 781-1989

Re: U.S. Patent Application
Serial No.: 09/440,371
Filing Date: 12 November 1999
For: ***Binding Acceleration Techniques for
the Detection of Analytes***
Inventors: Blackburn *et al.*
Our File No.: A-66566-3/RFT/RMS/RMK

***I hereby confirm my refusal to sign the Declaration for Patent Application with
respect to the above-referenced matter.***

Signature: _____
Stephen D. O'Connor

Dated: _____



TRANSMISSION RESULT REPORT(FEB 22 '00 01:16PM).....

FLEHR HOHBACH TEST

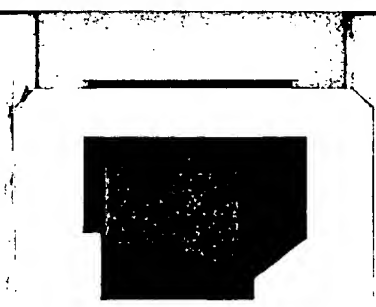
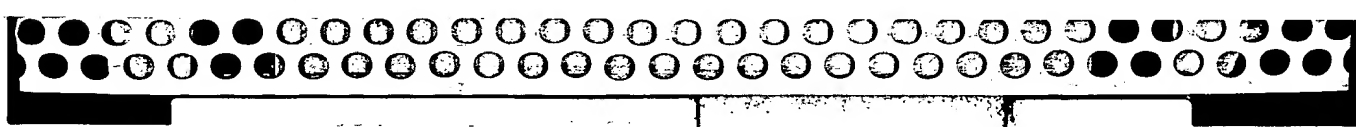
..... (AUTO)

THE FOLLOWING FILE(S) ERASED

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047	TRANSMISSION		16265359620	03	OK

ERRORS

- 1) HANG UP OR LINE FAIL 2) BUSY 3) NO ANSWER 4) NO FACSIMILE CONNECTION



VIA FACSIMILE

TO: Renee M. Kosslak
Flehr Hohbach Test Albritton & Herbert LLP
Four Embarcadero Center - Suite 3400
San Francisco, California 94111-4187
Fax: (415) 398-3249
Tel.: (415) 781-1989

Re: U.S. Patent Application
Serial No.: 09/440,371
Filing Date: 12 November 1999
For: *Binding Acceleration Techniques for
the Detection of Analytes*
Inventors: Blackburn *et al.*
Our File No.: A-66566-3/RFT/RMS/RMK

*I hereby confirm my refusal to sign the Declaration for Patent Application with
respect to the above-referenced matter.*

Signature: _____

Stephen D. O'Connor

Dated: _____

2-22-00

APPLICANT'S
EXHIBIT

3

Notice to Employee as to Change in Relationship

(Issued pursuant to provisions of Section 1089
of the California Unemployment Insurance Code)

Name of Employer:

Clinical Micro Sensors, Inc

Employee's Name: Steve O'Connor

Social Security # 512-84-3300

1. You were laid off/discharged on
2. You were on leave of absence starting
3. Your status changed from an employee
to an independent contract on 2-13-99

Representative of Employer:

Name: Ginger Beason Title: Human Resource Manager

Signature: Ginger Beason

Received By: Steve O'Connor

Signature: SO

CLINICAL MICRO SENSORS, INC.

EMPLOYEE PROPRIETARY INFORMATION AGREEMENT

As an employee of Clinical Micro Sensors, Inc., its subsidiaries, parent company or affiliates (together, the "Company"), and in consideration of the compensation previously and hereafter paid to me, I agree to the following:

1. MAINTAINING CONFIDENTIAL INFORMATION

a. Company Information. I agree at all times during the term of my employment and thereafter to hold in strictest confidence, and not to use, except for the benefit of the Company, or to disclose to any person, firm or corporation without written authorization of the President of the Company, any trade secrets, confidential knowledge, data or other proprietary information relating to products, processes, know-how, designs, formulae, developmental or experimental work, computer programs, data bases, other original works of authorship, customer lists, business plans, financial information or other subject matter pertaining to any business of the Company or any of its clients, consultants, or licensees.

b. Former Employer Information. I agree that I will not, during my employment with the Company, improperly use or disclose any proprietary information or trade secrets of my former or concurrent employers or companies, if any, and that I will not bring onto the premises of the Company any unpublished document or any property belonging to my former or concurrent employers or companies, if any, unless consented to in writing by such employers or companies.

c. Third Party Information. I recognize that the Company has received and in the future will receive from third parties their confidential or proprietary information subject to a duty on the Company's part to maintain the confidentiality of such information and to use it only for certain limited purposes. I agree that I owe the Company and such third parties, during the term of my employment and thereafter, a duty to hold all such confidential or proprietary information in the strictest confidence and not to disclose it to any person, firm or corporation (except as necessary in carrying out my work for the Company consistent with the Company's agreement with such third party) or to use it for the benefit of anyone other than for the Company or such third party (consistent with the Company's agreement with such third party) without the express written authorization of the President of the Company.

2. RETAINING AND ASSIGNING INVENTIONS AND ORIGINAL WORKS

a. Inventions and Original Works Retained by Me. I have attached hereto, as Exhibit A, a list describing all inventions, original works of authorship, developments, improvements, and trade secrets which were made by me prior to my employment with the Company, which belong to me, which relate to the Company's proposed business and products, and which are not assigned to the Company; or, if no such list is attached I represent that there are no such inventions.

b. Inventions and Original Works Assigned to the Company.
I agree that I will promptly make full written disclosure to the Company, will hold in trust for the sole right and benefit of the Company, and will assign to the Company all my right, title, and interest in and to any and all inventions, original works of authorship, developments, improvements or trade secrets which I have solely or jointly conceived or developed or reduced to practice, or caused to be conceived or developed or reduced to practice, during the period of time I have been in the employ of the Company or which I may solely or jointly conceive or develop or reduce to practice, during the period of time I shall be in the employ of the Company. I recognize, however, that Section 2870 of the California Labor Code (as set forth in Exhibit B hereto) exempts from this provision any invention as to which I can prove the following:

- i. It was developed entirely on my own time; and
- ii. No equipment, supplies, facility or trade secret of the Company was used in its development; and
- iii. It neither
 - (1) relates at the time of its conception or reduction to practice to the business of the Company or to the Company's actual or demonstrably anticipated research and development; nor
 - (2) results from any work performed by me for the Company.

I acknowledge that all original works of authorship which have been and will be made by me (solely or jointly with others) within the scope of my employment and which are protectable by copyright are "works made for hire," as that term is defined in the United States Copyright Act (17 USCA Section 101).

c. Maintenance of Records. I agree to keep and maintain adequate and current written records of all inventions and original works of authorship made by me (solely or jointly with

others) during the term of my employment with the Company. The records will be in the form of notes, sketches, drawings, and any other format that may be specified by the Company. The records will be available to and remain the sole property of the Company at all times.

d. Inventions Assigned to the United States. I agree to assign to the United States government all my right, title, and interest in and to any and all inventions, original works of authorship, developments, improvements or trade secrets whenever such full title is required to be in the United States by a contract between the Company and the United States or any of its agencies.

e. Obtaining Letters Patent and Copyright Registrations. I agree that my obligation to assist the Company to obtain United States or foreign letters patent and copyright registrations covering inventions and original works of authorship assigned hereunder to the Company shall continue beyond the termination of my employment, but the Company shall compensate me at a reasonable rate for time actually spent by me at the Company's request on such assistance. If the Company is unable because of my mental or physical incapacity or for any other reason to secure my signature to apply for or to pursue any application for any United States or foreign letters patent or copyright registrations covering inventions or original works of authorship assigned to the Company as above, then I hereby irrevocably designate and appoint the Company and its duly authorized officers and agents as my agent and attorney in fact, to act for and in my behalf and stead, to execute and further the prosecution and issuance of letters patent or copyright registrations thereon with the same legal force and effect as if executed by me. I hereby waive and quitclaim to the Company any and all claims, of any nature whatsoever, which I now or may hereafter have for infringement of any patents or copyright resulting from any such application for letters patent or copyright registration assigned hereunder to the Company.

f. Exception to Assignments. I understand that the provisions of this Agreement requiring assignment to the Company do not apply to any invention which qualifies fully under the provisions of Section 2870 of the California Labor Code, a copy of which is attached hereto as Exhibit B. I will advise the Company promptly in writing of any inventions, original works of authorship, developments, improvements or trade secrets that I believe meet the criteria in Subparagraphs 2b(i), (ii), and (iii) above; and I will at that time provide to the Company in writing all evidence necessary to substantiate that belief. I understand that the company will keep in confidence and will not disclose to third parties without my consent any confidential information

disclosed in writing to the Company relating to inventions that qualify fully under the provisions of Section 2870 of the California Labor Code.

3. CONFLICTING EMPLOYMENT

I agree that, during the term of my employment with the Company, I will devote full time to the business of the Company and will not engage in any other employment, occupation, consulting or other business activity directly or indirectly related to the business in which the Company is now involved or becomes involved during the term of my employment, nor will I engage in any other activities that conflict with my obligations to the Company. If I wish to engage in any other employment during the time I am engaged by the Company, I will first obtain the Company's written consent before accepting such additional employment.

4. NO BREACH OF DUTY

I represent that my performance of all the terms of this Agreement and as an employee of the Company does not, and to the best of my present knowledge and belief, will not breach any agreement or duty to keep in confidence proprietary information acquired by me in confidence or in trust prior to my employment by the Company. I have not entered into, and I agree I will not enter into, any agreement either written or oral in conflict herewith. I am not at the present time restricted from being employed by the Company or entering into this Agreement.

5. RETURNING COMPANY DOCUMENTS

I agree that, at the time of leaving the employ of the Company, I will deliver to the Company (and will not keep in my possession or deliver to anyone else) any and all devices, records, data, notes, reports, proposals, lists, correspondence, specifications, drawings, blueprints, sketches, materials, equipment, other documents or property, or reproductions of any aforementioned items belonging to the Company, its successors or assigns. In the event of the termination of my employment, I agree to sign and deliver the "Termination Certification" attached hereto as Exhibit C.

6. NON-SOLICITATION; NON-COMPETITION

During the term of my employment by the Company, and for twelve months thereafter, I shall not, directly or indirectly, without the prior written consent of the Company;

a. solicit or induce any employee of the Company to leave the employ of the Company or hire for any purpose any employee of the Company or any former employee who has left the employment of the Company within six months of the date of termination of such employee's employment with the Company; or

b. solicit or accept employment or be retained by any party who, at any time during the term of my employment, was a client, consultant, or joint venture partner of the Company if such entity is engaged in any activity, business or enterprise that is competitive with any significant part of the business conducted by the Company or any subsidiary or affiliate thereof at the time of the termination of my employment or as contemplated to be conducted by the Company at such time;

c. solicit or accept the business of any client of the Company, in any manner which is competitive (directly or indirectly) with the Company or any subsidiary or affiliate or joint venture partner thereof; or

d. become employed by, or perform services for, any business which is competitive with any significant part of the business conducted by the Company or any subsidiary or affiliate thereof at the time of the termination of my employment or as contemplated to be conducted by the Company at such time in any county in which the Company is then doing business.

I recognize, understand, agree and acknowledge that the Company has a legitimate and necessary interest in protecting its goodwill and confidential information and that the identity and particular business needs of clients will be conveyed to me during the term of my employment and such information constitutes confidential information which is not publicly available.

7. INJUNCTIVE RELIEF

I understand that any breach by me of any of the obligations hereunder relating to the protection of Company proprietary information could cause the Company to suffer great harm for which money damages alone might not constitute adequate or reasonable compensation. I therefore agree that the Company shall be entitled to obtain injunctive relief from a court of competent jurisdiction in order to prevent an anticipated or continuing breach of my obligations hereunder. I also agree that such injunctive relief may be imposed without the necessity for the Company to post a bond.

8. AT-WILL EMPLOYMENT

I agree that unless specifically provided in another writing signed by me and (a) an executive officer of the Company if I am not an executive officer of the Company, or (b) another executive officer of the Company if I am an executive officer of the Company, my employment by the Company is not for an indefinite period of time. Rather, my employment relationship with the Company may be terminated at any time, with or without cause, by me or by the Company. Nothing in this Agreement is intended to change the nature of that relationship.

9. GENERAL PROVISIONS

a. California Law. This Agreement will be governed by the laws of the State of California.

b. Entire Agreement. This Agreement sets forth the entire agreement and understanding between the Company and me relating to the subject matter herein and merges all prior discussions between us. No modification of or amendment to this Agreement, nor any waiver of any rights under this agreement, will be effective unless in writing signed by the party to be charged. Any subsequent change or changes in my duties, salary or compensation will not affect the validity or scope of this Agreement.

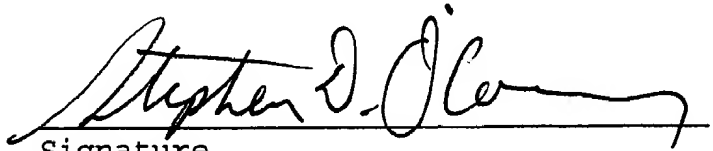
c. Severability. If one or more of the provisions in this Agreement are deemed void by law, then the remaining provisions will continue in full force and effect.

d. Successors and Assigns. This Agreement will be binding upon my heirs, executors, administrators and other legal representatives and will be for the benefit of the Company, its successors, and its assigns.

Date:

4-3-96

Signature



Stephen D. O'Connor

Name of Employee (typed or printed)

ACCEPTED AND AGREED TO:

CLINICAL MICRO SENSORS, INC.

By: [Signature]
Title: President

EXHIBIT A

LIST OF PRIOR INVENTIONS
AND ORIGINAL WORKS OF AUTHORSHIP

<u>TITLE</u>	<u>DATE</u>	<u>IDENTIFYING NUMBER OR BRIEF DESCRIPTION</u>
--------------	-------------	--

EXHIBIT B

CALIFORNIA LABOR CODE SECTION 2870
EMPLOYMENT AGREEMENTS, ASSIGNMENT OF RIGHTS

California Labor Code § 2870. Application of provision providing that employee shall assign or offer to assign rights in invention to employer.

- (a) Any provision in an employment agreement which provides that an employee shall assign, or offer to assign, any of his or her rights in an invention to his or her employer shall not apply to an invention that the employee developed entirely on his or her own time without using the employer's equipment, supplies, facilities, or trade secret information except for those inventions that either:
 - (1) Relate at the time of conception or reduction to practice of the invention to the employer's business, or actual or demonstrably anticipated research or development of the employer; or
 - (2) Result from any work performed by the employee for the employer.
- (b) To the extent a provision in an employment agreement purports to require an employee to assign an invention otherwise excluded from being required to be assigned under subdivision (a), the provision is against the public policy of this state and is unenforceable.

Added Stats 1979 ch 1001 § 1; Amended Stats 1986 ch 346 § 1;
Amended Stats 1991 ch 647 § 5.

EXHIBIT C
CLINICAL MICRO SENSORS, INC.
TERMINATION CERTIFICATION

This is to certify that I do not have in my possession, nor have I failed to return, any devices, records, data, notes, reports, blueprints, sketches, materials, equipment, other documents or property, or reproductions of any aforementioned items belonging to Clinical Micro Sensors, Inc., its subsidiaries, affiliates, successors or assigns (together, the "Company").

I further certify that I have complied with all the terms of the Company's Proprietary Information Agreement signed by me, including the reporting of any inventions and original works of authorship (as defined therein) conceived or made by me (solely or jointly with others) covered by that agreement.

I further agree that, in compliance with the Proprietary Information Agreement, I will preserve as confidential all trade secrets, confidential knowledge, data or other proprietary information relating to products, processes, know-how, designs, formulas, developmental or experimental work, computer programs, data bases, other original works of authorship, customer lists, business plans, financial information or other subject matter pertaining to any business of the Company or any of its clients, consultants or licensees.

Date: _____

Employee's Signature

Name of Employee (typed or printed)